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26584 7590 09/28/2010 OTIS ELEVATOR COMPANY INTELLECTUAL PROPERTY DEPARTMENT 10 FARM SPRINGS FARMINGTON, CT 06032				
EXAMINER				
KRUEER, STEFAN				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD J. ERICSON, HUGH J. O'DONNELL,
ARY O. MELLO, DALE R. BARRETT, and DENNIS J. REHMER

Appeal 2009-007986
Application 10/684,171
Technology Center 3600

Before: WILLIAM F. PATE III, JENNIFER D. BAHR, and
STEFAN STAICOVICI, *Administrative Patent Judges*.

PATE III, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 22, 23, 25, and 26. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

The claims are directed to an end connector for an elevator cable. Claim 22, reproduced below, is illustrative of the claimed subject matter:

22. An elevator system having a tension member for suspending the elevator loads and a termination device for the tension member, the termination device including:

a first compressive system to engage and compress the tension member to provide a first retaining mechanism; and

a second compressive system comprising a clamp engaging the tension member, the second compressive system prevents further slippage of the tension member by mechanical deformation of the tension member only when slippage of the tension member through the device first occurs.

REFERENCE

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Mardis

US 2,189,671

Feb. 6, 1940

REJECTION

Claims 22, 23, 25 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mardis. Ans. 3.

OPINION

We have carefully reviewed the rejection on appeal in light of the arguments of the Appellants and the Examiner. As a result of this review, we

have determined that the applied prior art does not establish the lack of novelty of claims 22, 23, 25, and 26. Therefore, the rejection of these claims under 35 U.S.C. § 102 is reversed. Our reasons follow.

The independent claim on appeal requires a first compressive system and a second compressive system. We agree with the Examiner that Mardis discloses a first compressive system – plate like members 2 and 6 which capture the rope 9 therebetween. *See* page 1, col. 1, l. 44 – page 1, col. 2, l. 19. We also agree that Mardis discloses a second compressive system comprised of a pair of U-bolts 18. *See* page 1, col. 2, ll. 36-50. The claim further requires that the second compressive system prevent further slippage of the tension member by mechanical deformation of the tension member were the first compressive system to malfunction.

The Examiner states that this function is inherently provided by the article of Mardis. *See* Ans. 3, penultimate sentence. The Appellants argue that Mardis is unable to perform this function. Appellants base their argument on a passage from page 2, column 1 of Mardis, lines 12-17 where Mardis states, “It will also be seen that the rope thimble of this invention is clamped securely over substantially the entire loop of the rope, thereby eliminating the danger of any slippage or distortion whatsoever of any of the strands or that part of the rope looped around the thimble.” *See* Br. 4.

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference.’” *See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Based on the above quoted portion of the Mardis specification, it is our finding that the Examiner’s determination of inherency is based on speculation and conjecture. We do not believe that the argued function is necessarily present in the operation of the Mardis device, since Mardis

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denies slippage can occur, and he intends that no distortion (deformation) of the strands [of the rope] be permitted. P. 2, col. 1, ll. 14-16. Inasmuch as Appellants have sustained their burden of showing a claimed feature is not necessarily present or inherent in the Mardis disclosure, it is our finding that Mardis does not anticipate the claimed subject matter. Accordingly, we reverse the 35 U.S.C. § 102 rejection on appeal.

DECISION

The rejection of claims 22, 23, 25, and 26 under 35 U.S.C. § 102 is reversed.

REVERSED

nlk

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